



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,496	11/28/2000	Zaid Joyyosi	02481.1691-00	6965

7590 01/21/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET NW
WASHINGTON, DC 20005-3315

EXAMINER

FEDOWITZ, MATTHEW L

ART UNIT	PAPER NUMBER
----------	--------------

1623

DATE MAILED: 01/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,496

Applicant(s)

JOYYOSI ET AL.

Examiner

Matthew L. Fedowitz

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,7,11,14,15,21-23,27,31,34-37,49,89,91 and 93-97 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,7,11,14,15,23,27,31 and 34-37 is/are rejected.
- 7) ☒ Claim(s) 2, 21, 22, 49, 89, 91, 93, 94-97 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/28/2002</u> . | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

Claims 1, 2, 7, 11, 14, 15, 21, 22, 23, 27, 31, 34, 35, 36, 37, 49, 89, 91, 93, 94, 95, 96 and 97 are pending in this application.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 4, 2004 has been entered.

The method of use claims will not be rejoined because none of claims drawn to the product have been found to be allowable MPEP § 821.04.

The applicant's remarks with regard to claims 50-82 and 66 are unclear because the applicant requests that claims 50-82 remain withdrawn and also requests that claim 66 be examined. The applicant must clarify this request.

Claim Rejections - 35 USC § 102

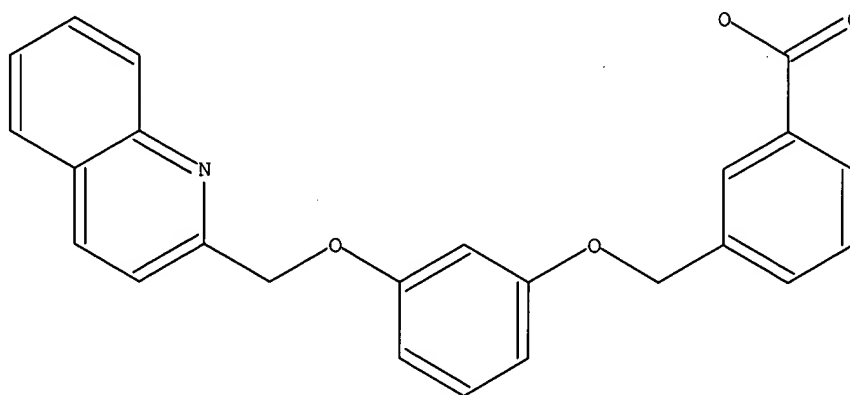
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 1623

Claims 1, 7, 11, 14, 15, 23, 27, 31, 34, 35, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Jayyosi *et al.* (US 6,376,512). Jayyosi *et al.* teach the compound below as claimed in the instant invention (see column 19 and claim 13 column 106).



As relating to claims 1, 7, 11, 14, 15, 23, 27, 31, 34, 35, 36 and 37, where Ar I is defined as a pyridyl that is optionally substituted by one or more ring system substituents, the teachings of Jayyosi *et al.* read on the claimed invention. This because when the pyridyl is optionally substituted the structure shown above will result in the Ar I position. Moreover, the Jayyosi *et al.* structure above reads on the instant invention where Ar II and Ar III are aryl; A and B are O; D and E are chemical bonds; a, d, f are 1; b, c and e are 0; R₁, R₃, R₅, R₇, R₉, and R₁₁ are H; R₂, R₄, R₆, R₈, R₁₀, and R₁₂ are -(CH₂)_q- with q being 0 and X being H; Z is R₂₁O₂C- with R₂₁ as H and where R' and R'' are H.

Claim Objections

Claims 2, 21, 22, 49, 89, 91, 93, 94, 95, 96 and 97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Matthew L. Fedowitz whose telephone number is (571) 272-3105 and can be reached between 9am-5:30pm (EST) M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's primary, Mr. James O. Wilson, can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew L. Fedowitz, Pharm.D., J.D.
November 30, 2004



James O. Wilson
Supervisory Patent Examiner
Art Unit 1623